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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,733	08/30/2000	Alejandro M. Pilato	11725-46001	2432

7590 08/27/2003

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EXAMINER

FULTS, RICHARD C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/650,733

Applicant(s)

PILATO, ALEJANDRO M.

Examiner

Richard Fults

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-139 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-139 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

DETAILED ACTION

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-139 are rejected under USC 101 because the claimed invention is directed to non-statutory subject matter. For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result,

AND

2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section IV 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished). There is no technology contained within the body of these claims.

Dependant claims 2-111 and 115-135 are rejected for incorporating the defects from the parent claims by dependency.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over ATKINS (US 5,644,727 A) in view of JONES et al (US 6,021,397) (hereinafter Jones).

As to claims 1-139 Atkins explicitly discloses (see columns 1-80) the computerized provision of financial services and functions, both directly and through advice and recommendations and guidelines of management and investment objectives, to a plurality of clients regarding both the active and recommended management of a wide variety of credit, debt, treasury, and assets and liabilities, pension funds, portfolios, leases, trading, and indirectly through a plurality of investment asset classes commodity prices and real estate. Included in the provision of these financial functions are both the enabling of and action of normal communications of agent's actions and intent and advice, reporting of information and results, receiving of financial information, record keeping, creation of risk management information, all the computer information, network, and apparatus means needed to implement the financial functions, an apparatus for providing financial functions by an agent for each of a plurality of clients and a computer-readable medium storing instructions that when executed by one or more processors cause the one or more processors to perform relating to a financial function of each client, demonstrating that more than one activity of the agent can be transparent to the client, receiving financial information at the agent, creating risk management information relating to the financial information, analyzing the risk management in the context of the financial information, determining an action based on the analysis, facilitating implementation of the action on behalf of the client,

communicating with the client through a network one or more activities, a method for a client to outsource financial functions to an agent representing a plurality of clients providing and an apparatus for the means for providing financial information on one or more financial functions of the client to the agent, and an apparatus means for enabling the agent to determine an action based on the analysis of risk management information created from the financial information, and an apparatus means for allowing the agent to facilitate the implementation of the action, a method for an agent to provide financial functions to each of a plurality of clients regarding a financial function of a client from the plurality of clients, demonstrating to the client the potential transparency of activities of the agent, receiving financial information at the agent, analyzing risk management information created from and in the context of the financial information, facilitating implementation on behalf of an agent's action based on the analysis, and enabling the client to monitor through a network activities of the agent. Atkins does not explicitly teach an agent, or risk analysis, or transparency, or commodities.

Jones teaches (see columns 1-24) the transparency of financial activities to the client, the analysis of risk management information, the action based on that analysis, facilitating implementation of that action, and the communication of the financial activities to the client through a network. Jones also discloses the use of computer information, network, and apparatus needed to perform these transparency and risk related activities.

Because the teachings of both Atkins and Jones have been common practices in the provision of financial functions to a plurality of clients and the fact that the combination of the two would provide a more comprehensive and efficient set of financial services that would be common sense and be advantageous to the clients, it would have been obvious to one skilled in the art at the time of the invention to add teachings of Jones to those of Atkins, and to add the teachings of Atkins to those of Jones for the same reason.

While Atkins does not explicitly teach an agent, it would have been obvious to one skilled in the art at the time of the invention that an agent is simply a representative of the principal, and that it is common and advantageous for most principals to operate through either computers or other people, including employees, all of whom or which are agents representing the principal or the organization, and that the teachings of Atkins regarding risk preferences and risk aversion would obviously and commonly include risk analysis and the financial functions closely related to that process, and that while Atkins does not specifically teach the management of commodities or commodity price, it would have been obvious to one skilled in the art at the time of the invention to be aware of the fact that commodities are one class of assets that are commonly included in an investment portfolio, and Atkins does teach the management of an investment portfolio.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is 703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough, can be reached on (703)-305-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326 before final and 703-872-9327 after final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
RCF

8/14/2003



JEFFREY PWU  
PRIMARY EXAMINER